



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

TOWNSEND AND TOWNSEND AND CREW
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO CA 94111-3834

COPY MAILED

NOV 24 2004

OFFICE OF PETITIONS

In re Application of :
Wen-Hwa Lee, Huei-Jen Su Huang, Eva: :
Y.H.P. Lee, Theodore Friedmann, and: DECISION ON PETITIONS
Jiing-Kuan Yee :
Application No. 10/028,726 :
Filed: December 21, 2001 :
Attorney Docket No. 20350 :

This is a decision on the petitions under 37 CFR 1.47(a) and 37 CFR 1.48, both filed July 19, 2004. The petition under 37 CFR 1.47(a) is being treated as a petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.48(a)(3).

The petition under 37 CFR 1.183 is **DISMISSED**.

The petition under 37 CFR 1.48(a) is **DISMISSED**.

Petitioner is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.183 to waive the requirement of 37 CFR 1.48(a)(3)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventors. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on December 21, 2001 with a declaration executed by Wen-Hwa Lee, Huei-Jen Su Huang,

and Eva Y.H.P. Lee as joint inventors. On July 19, 2004, the instant petition under 37 CFR 1.48(a) was filed to amend the inventorship to add joint inventors Theodore Friedman and Jiing-Kuan Yee.

37 CFR 1.48(a) requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
- (4) The processing fee set forth in § 1.17(i); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

Petitioner has satisfied requirements (1), (2), and (4) above. The petition specifically requests the addition of inventors Friedman and Yee. Petitioner has included the required statements from Friedman and Yee. Petitioner has paid the processing fee.

With respect to requirement (3), petitioner has not submitted a 37 CFR 1.63 declaration executed by all of the inventors as required by 37 CFR 1.48(a)(3). The 37 CFR 1.63 declaration was not executed by inventors Lee, Huang, and Lee. In order for a petition under 37 CFR 1.183 to be granted, petitioner must demonstrate that this is an extraordinary situation where justice requires waiver of the rules. In the "Declaration to Support Petition Under 37 CFR 1.48(a)", petitioner attested that copies of the corrected declaration were forwarded to Lee, Huang, and Lee. Inventors Lee and Lee made an oral refusal to sign the declaration during a telephone conversation with petitioner. The corrected declaration was received by Huang (as evidenced by Federal Express tracking receipts), but never returned.

However, petitioner has not satisfied requirement (5). While the petition includes a statement signed by Patricia Anderson Cotton, Director of assignee The Regents of the University of California, petitioner has not indicated the Reel and Frame number where the assignment is recorded.

On renewed petition, petitioner must submit a proper statement under 37 CFR 3.73(b). No additional fee is required on renewed petition.

Further correspondence with respect to this matter should be addressed as follows:

Application No. 10/028,726

Page 3

By mail: Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

By FAX: (703) 872-9306
Attn: Office of Petitions

Telephone inquiries related to this decision may be directed to
Petitions Attorney Cliff Congo at (571)272-3207.

A handwritten signature in black ink, appearing to read "Charles Pearson". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Charles Pearson
Director
Office of Petitions